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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,244	02/19/1999	STEFAN BREUNIG	022701-803	2643

21839 7590 12/14/2004

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
MOORE, MARGARET G	
ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/202,244	BREUNIG ET AL.
	Examiner	Art Unit
	Margaret G. Moore	1712

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *23 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23, 29 to 33, 37 to 40, 42 and 48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23, 29 to 33, 37 to 40, 42 and 48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Applicant's amendment filed 9/24/04 (not entered after final) has been entered in this RCE application. The amendment has overcome the obviousness rejection over Bailey by eliminating the reactant that was claimed and taught by Bailey. The rejection of claims 37 and 38 over Crivello et al. is maintained, as noted below, and a new ground of rejection under 35 USC 103 has been made.

2. Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims refer to the "silicone oil according to claim 48" but claim 48 is not not drawn to a silicone oil. This is confusing.

Also, in claim 37, the phrase "from components comprising using" makes no sense.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 29 to 32, 37 to 40 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ona et al. in view of Bailey.

One et al. teach epoxy siloxanes. See formula (C) on column 2, and note that "z" can be zero. Also note that E can be an epoxy group corresponding to the structure (IX) in claim 48. The bottom of column 5 teaches that these epoxy siloxanes can be prepared by the reaction specified in 2,970,150, Bailey.

The teachings of Bailey were addressed in the office actions dated 2/3/04 (para 6 and 7) and 6/24/04 (para 3 and 4). Bailey teaches preparing silicone oils by hydrosilylating in the presence of a heterogeneous catalyst comprising platinum on an inert charcoal or alumina support. See for instance column 3, lines 5 to 15, Example 15 and claim 15.

In view of the teaching in Ona et al. that the epoxy siloxane therein is prepared by the reaction in Bailey, one having ordinary skill in the art would have been motivated

to select a synthon corresponding to (IX) in claim 48 and react it with polyorganohydrosiloxane in the presence of a platinum catalyst supported on charcoal or alumina to form the epoxy siloxane in Ona et al. When "z" is zero in Ona et al., the polyorganohydrosiloxane necessary to form the formula (C) will correspond to Formula (XVI) in claim 48. Since one has motivation to select the polyorganohydrosiloxane and synthon required by claim 48 to form an epoxy siloxane, and the only catalyst suggested by Ona et al. is a supported catalyst that meets that required by claim 48, the instant claims are rendered obvious by these references.

With regard to claim 29, note that adjusting the molar ratio of the reactants in an effort to optimize and/or adjust the reaction product would have been obvious. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). For instance note that Example 15, which is uses an epoxy synthon, uses a molar ratio within the claimed range.

With regard to claims 30 and 32, these limitations are taught by Bailey on lines 5 to 15 of column 3. Regarding claim 31, as noted in the office action dated 2/3/04, adjusting the amount of catalyst in the reaction mixture, in an effort to determine the optimum amount of catalyst, would have been within the skill of the ordinary artisan.

Ona et al. prepare a coating composition, thus meeting the requirement of claim 38. Claim 37 only requires "forming" an anti-adhesion product "using" the silicone oil. Thus forming the siloxane or using it as a coating, as in Ona et al., meets these limitations.

Finally, with regard to claims 39 and 40, these reaction steps and conditions are taught by Bailey. See for instance Example 15 which uses an inert atmosphere (i.e. ambient atmosphere), heating at a temperature as claimed, a molar ratio as claimed, filtering and devolatilization. Again, column 3 teaches an amount of catalyst meeting that in claim 39. Example 15 does not use a solvent.

5. Claims 23 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ona et al. in view of Bailey as applied to claims 29 to 32, 37 to 40 and 48 above, and further in view of Togashi et al.

Bailey fails to teach a carbon black support for this hydrosilylation reaction.

Togashi et al. teach a hydrosilylation reaction between SiH siloxanes and unsaturated compounds. Column 4, lines 33 and 34, teaches that platinum catalysts used for hydrosilylation reactions can be supported on alumina, silica or carbon black. Thus Togashi et al. indicate that carbon black can be used as an alternative to alumina as a platinum catalyst support.

Thus one having ordinary skill in the art would have found the use of a carbon black support for the reaction in Bailey rather than the alumina support taught therein to have been obvious. It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious.

6. Claims 37 and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Crivello et al.

The basis for this rejection was detailed in the previous office action. See paragraph 5 of the action dated 6/24/04 and paragraph 8 of the action dated 2/3/04. These claims are process claims, but seemingly include a product by process limitation. (The Examiner states that they "seemingly" include a product by process limitation because the claims do not actually state that the silicone oil is *prepared by* the process of claim 48. See paragraph 2, supra, that addresses this inconsistency.).

While Crivello et al. do not teach the process of claim 48, the silicone oils prepared by Crivello et al. and instant process claim 48 appear to be inherently the same. Again note the rationale of record. Crivello et al. teach a process for preparing an anti-adhesion product and a coating; column 8, line 63, teaches a release coating. Thus, Crivello et al. teach a process meeting that in claims 37 and 38, but with the exception

that the silicone oil is not made by the process of claim 48. However, since the oils appear to be inherently the same, the processes claimed and the prior art processes appear to be inherently the same.

7. For the record the Examiner notes that she has withdrawn the obviousness rejection over claim 33. Bailey teaches on column 3, lines 20 to 25, that it is essential to stir the reaction throughout the time of treatment in order to disperse the solid catalyst within the liquid reaction phase. This fails to teach or suggest having the reactants pass over or through a stationary bed of catalyst.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 23, 29 to 33, 37 to 40, 42 and 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 16 of U.S. Patent No. 6,545,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because '115 requires the same siloxane and catalyst as required by instant claim 48 and the synthons in '115 include that claimed. See formula (IV) and (V) in claim 1 on '115 that meet the required synthon in claim 48. The process claimed is embraced by the breadth of claim 1 in '115. The reaction conditions of instant claim 39 are found in claim 1 of '115. Instant claims 23 and 42 correspond to claim 9 in '115. The limitation of instant claim 29 is found in claim 1 of

'115. Instant claims 30 to 32 correspond to claims 10, 11 and 7, respectively, in '115 while instant claim 33 is within the breadth of the catalyst in claim 1 of '115. None of the claims in '115 include a solvent, thus rendering obvious the limitation of claim 40. Claim 16 of '115 is drawn to a anti-adhesive product, rendering obvious claims 37 and 38.

10. Claims 23, 29 to 33, 37 to 40, 42 and 48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to14 of copending Application No. 10/933,542. Although the conflicting claims are not identical, they are not patentably distinct from each other because the siloxane required by instant claim 48 is within the breadth of the SiH organosilicon compound in claim 1 of '542 (see for instance claim 8 in '542) and the synthons claimed are within the breadth of the heterocyclic synthon in claim 1 of '542 (see for instance claim 6 of '542). '542 requires the same catalyst as that in claim 48. Instant claims 23 and 42 are found in claim 12 of '542. Instant claims 30 and 32 correspond to claims 9 to 11 in '542. Claims 29 and 33 are within the breadth of claim 1 in '542. The steps of instant claim 39 are found in claim 13 of '542 while instant claim 40 corresponds to claim 14 in '542. The anti-adhesive coating in claim 17 corresponds to claims 37 and 38.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
12/10/04